

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIHARU KONDO, YUKIO SHIRAKO, and TERUHITO NOSHIRO

Appeal No. 96-3810
Application No. 08/207,801¹

ON BRIEF

Before JERRY SMITH, DIXON, and GROSS, Administrative Patent Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8, which are all of the claims pending in this application.

¹ Application for patent filed March 7, 1994. According to appellants, the application is a continuation of Application 07/965,747, filed October 23, 1992, now abandoned.

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The appellant's invention relates to a postscript basis pre-TOC technique for recording data on an optical disc. More specifically, the method involves reading position data corresponding to already recorded data, determining the remaining data area, dividing the remaining area into plural units, and recording in the table of contents position data for both the already recorded data and the unit data areas. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. In an optical disc recording/reproducing apparatus having means for seeking a predetermined position on a postscript type optical disc, means for reading recorded data from said disc, and means for recording data and a time table on a predetermined data area and a table area of said disc, respectively, a method of recording said time table comprising the sequential steps of:
reading position data corresponding to a position of each recorded data on said disc;
detecting a remaining data area on which no data is recorded;
dividing said remaining data area into a plurality of unit data areas; and
recording position data of each recorded data and each unit data area on said time table area.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ando et al. (Ando)	4,862,439	Aug. 29, 1989
Strubbe et al. (Strubbe)	5,047,867	Sep. 10, 1991

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Nakajima et al. (Nakajima) 5,111,442 May 05, 1992

Claims 1 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ando in view of Strubbe, and further in view Nakajima for claims 5 through 8.

Reference is made to the Examiner's Answer (Paper No. 17, mailed May 9, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' Brief (Paper No. 16, filed April 1, 1996) for the appellants' arguments thereagainst.

OPINION

As a preliminary note, appellant indicates on page 3 of the Brief that the claims are to stand or fall together. Accordingly, we will consider claim 1, the broadest claim, as representative, and the remaining claims will stand or fall therewith.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejections of claims 1 through 8.

Ando discloses a disk recording and reproducing apparatus. As the examiner states (Answer, page 4), Ando "comprises means for seeking a particular position on a disk, reproducing information from the disk, recording data in a data area on the disk, and recording a table of contents (TOC) in a separate 'lead-in' area on the disk." As the examiner further explains, after TOC information is recorded for music data that has already been recorded, Ando determines the remaining available space on the disk by reading the position data for the recorded data and calculating the space that is left. The examiner concludes that Ando "lacks the teaching that the 'remaining time' or 'remaining data area' is divided into a plurality of equally sized spaces and the size of the plurality of spaces can be set."

The examiner turns to Strubbe for dividing unrecorded space into a plurality of units. Strubbe is directed to integrated control for a television receiver and a video cassette recorder. Strubbe includes an example in which the blank space of a video tape is divided into half hour blocks

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for future recording. In view of this example of Strubbe, the examiner concludes that it would have been obvious to modify the method of Ando by dividing the available recording space into a plurality of user specified fixed length units "to maximize the number of 'programs' that can be recorded, at various times, on a disk." (Answer page 5)

First, the examiner has not explained how a video cassette recording method is analogous to the invention and the optical disc recording method of Ando, and we fail to see how it is, as the two recording methods are very different. Therefore, we find that the video cassette recording method of Strubbe is not properly combinable with the optical disc recording method of Ando. It seems that the examiner might have made a better case by taking Ando with Nakajima (an apparatus for recording signals on an optical disc), but that combination is not before us.

Second, in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

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837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is required to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Here, the examiner has failed to point to any teaching or suggestion in Strubbe (or any reference) that dividing available space into fixed length units maximizes the number of programs that can be recorded. Furthermore, although television programs tend to last a half hour or some integral multiple

thereof, and therefore fit nicely into spaces that are integral multiples of half hours, music does not have the same predictability of length. Therefore, it would not have been obvious to one of ordinary skill in the art to divide the unrecorded space for maximizing the number of pieces that can be recorded. In addition, since Ando calculates the lengths of the various spaces and selects the spaces according to which one most closely matches the size of the musical work to be recorded, it would have been counterintuitive to divide the space into fixed length units as proposed by the examiner.

Lastly, the examiner further has failed to establish a prima facie case of obviousness, since the examiner has not accounted for every limitation in the claim. The last step of claim 1 requires "recording position data of each recorded data and each unit data area on said time table area." Since the claim specifies that the steps are to be done sequentially, the recordation of both the position data of the recorded work and the unit data area must be done after the unused data area is divided into units. Furthermore, each

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unit data must be recorded. The examiner asserts (Answer, page 5) that once the blank recording space is divided according to Strubbe, "the TOC of Ando et al. would be updated to include position and time information for each of the newly designated unit areas of blank space." However, in Ando the TOC is updated after the recordation of additional pieces, to include all works that are recorded subsequent to the original recording session, but information for any remaining available space is not recorded. As the examiner has provided no motivation for changing the timing for or method of updating the TOC of Ando, he simply has failed to meet the last limitation of claim 1. Accordingly, we cannot sustain the rejection of the claim 1. Further, since the remaining claims stand or fall with claim 1, we must reverse the rejection of claims 2 through 8 as well.

CONCLUSION

The decision of the examiner rejecting claims 1 through 8 under 35 U.S.C. § 103 is reversed.

REVERSED

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Administrative Patent Judge)	AND
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